

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appl. of: Yingjian Chen, et al.
Serial No.: 10/788,765
Filing Date: 02/27/2004
For: MAGNETIC SENSOR WITH
UNDERLAYERS PROMOTING HIGH-
COERCIVITY, IN-PLANE BIAS LAYERS

Art Unit: 2627
Examiner: TO BE ASSIGNED
Confirmation No.: 8460
Docket No.: R1850

**RENEWED PETITION
UNDER 37 CFR § 1.137(b)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner:

In response to the Decision on Petition mailed on 10/24/2007 for the above-identified patent application, please consider the following Remarks.

REMARKS

This Renewed Petition is submitted in response to the dismissal of the previous Petition to Revive an Unintentionally Abandoned Application filed on 2/6/2007 (the "Petition"). The present Application was abandoned after the expiration of the reply period to a Notice of Missing Parts mailed 5/19/2004 requiring an executed oath or declaration by inventor Mohamad T. Krounbi followed by a Notice of Incomplete Reply mailed 11/16/2004 to a response that did not include the signature. In the dismissal of the Petition, the Office noted that it had not been demonstrated to the satisfaction of the Director that the entire delay was unintentional for the following two periods: (1) the delay in reply that originally resulted in abandonment, and (2) the delay in filing an initial petition to revive the application. The Office also required submission of the entire Declaration, rather than merely the replacement signature page with Mr. Krounbi's signature. With respect to the latter requirement, the complete Declaration is submitted with this Renewed Petition. With respect to the former requirement, Applicants submit this Renewed Petition to demonstrate that the delay in these two periods was unintentional.

The undersigned attorney is the responsible attorney for the present Application at Western Digital Technologies, Inc., the parent company of Western Digital (Fremont), Inc., the latter of which is the assignee of record for the present Application (collectively, "Western Digital"). Western Digital owns a number of assets purchased from the bankruptcy of Read-Rite Corporation ("Read-Rite"), including all right, title, and interest in the present Application. The undersigned attorney has worked for Western Digital since May 2005 and has personal knowledge of the docketing system and procedures that were in use at Western Digital both at the time the present Application was abandoned and in the intervening time period through the filing of the present Renewed Petition. Based on the docketing system and procedures that have been followed from the time of abandonment through the filing date of the present Renewed Petition, the delay in both of the periods specified above was entirely unintentional.

At the time the present Application was originally filed (2/27/2004), one of the inventors, Mohamad T. Krounbi, who had previously worked for Read-Rite, was not

employed by Western Digital. The formal papers were sent for signature to the facility previously owned by Read-Rite, and since Mr. Krounbi was not there, they were returned without Mr. Krounbi's signature. The present Application was filed with the Declaration that omitted his signature. On May 19, 2004, the Notice to File Missing Parts was sent. It was recognized that Mr. Krounbi had not signed the papers, and the formal papers were emailed to Mr. Krounbi's last known email address on October 25, 2004 (see Exhibit A to this Renewed Petition). A response to the Notice of Missing Parts was erroneously filed on November 5, 2004 before Mr. Krounbi had returned the papers, and a Notice of Incomplete Reply was mailed November 16, 2004. At that time, the reply from Mr. Krounbi was still expected, upon which a response and petition to revive could be filed. Unfortunately, Mr. Krounbi never returned the signed papers. Because Mr. Krounbi's signed papers did not arrive when expected, which would have been the trigger for the response to the Notice of Missing Parts, the Application was unintentionally abandoned during period (1). No Notice of Abandonment was sent by the Office at this time.

This circumstance of abandonment likely would not have been discovered but for an ongoing, non-routine review of Read-Rite patent applications acquired by Western Digital. When the review reached this case, it was recognized that the case had been unintentionally abandoned, and another request was sent to Mr. Krounbi for his signature on February 21, 2006 (see Exhibit B to this Renewed Petition), in response to which Mr. Krounbi indicated that he had signed the papers and would return them. Shortly thereafter, a Notice of Abandonment was received on April 4, 2006, by Janyce Mitchell, an attorney who had done work for Western Digital in the past but who was not the attorney of record in the present Application. Ms. Mitchell notified the undersigned attorney, and the undersigned attorney determined that Western Digital had managed to obtain Mr. Krounbi's signature on the documents (which Western Digital expected to receive shortly) and informed Ms. Mitchell that Western Digital planned to file a petition to revive the application (see Exhibit C to this petition). But when Mr. Krounbi's signed papers arrived, they were placed in the file for the present Application, which then was left in the undersigned attorney's office among numerous other files without any

notification to the undersigned attorney that they had arrived. Thus, the event that was to have prompted the communication to the Patent Office (i.e., the arrival of Mr. Krounbi's signed papers) did not trigger the filing of the petition and caused the petition inadvertently to go unfiled.

Again, this further delay in reviving the case likely would have gone entirely unnoticed but for the undersigned attorney having happened to notice in mid-January 2007 that the file for the present Application did not match any outstanding items on the undersigned attorney's electronic docket. Upon discovering the file, the undersigned attorney investigated the circumstances of the abandonment of the present Application and determined the situation to be as described above. At that time, the undersigned attorney promptly gathered the documents needed to respond to the Notice of Missing Parts and promptly filed the Petition to revive the unintentionally abandoned cases on February 6, 2007. Based on the facts as outlined in this Renewed Petition, the entire delay in period (2) was unintentional as well, in that it was not recognized that the case had been inadvertently abandoned until February 2006, upon which time the papers for the response to the Notice of Missing Parts were promptly requested from Mr. Krounbi, and it was not subsequently recognized that the response and petition to revive had gone unfiled until the file was rediscovered by the undersigned attorney in January 2007, at which time the petition to revive was promptly filed.

In both periods (1) and (2), the inadvertent omission of some trigger to filing the response and/or the petition to revive created the delay. In November 2004, it was the failure of Mr. Krounbi to return the signed papers as expected. In April 2006, it was the inadvertent failure to docket a response and to notify the responsible attorney that the papers signed by Mr. Krounbi had arrived. In both cases, upon discovery of the circumstances, prompt remedial action was taken (requesting formal papers from Mr. Krounbi in February 2006, filing the petition to revive in February 2007). Accordingly, Applicants respectfully submit that the entire period of delay in responding to the Notice of Missing Parts and in filing a petition to revive the present Application was inadvertent, and this Renewed Petition to revive the unintentionally abandoned Application should be granted.

CONCLUSION

As the circumstances outlined by the undersigned attorney in this Renewed Petition make clear, at no time during period (1) or period (2) did Western Digital *deliberately* delay in filing the petition. Because these circumstances demonstrate that the entire period of delay in responding to the Notice of Missing Parts and reviving the present Application was unintentional, this Renewed Petition to revive the present Application should be granted.

The Commissioner is hereby authorized to charge payment of any required fees associated with this Communication or credit any overpayment to Deposit Account No. 23-1055.

Respectfully submitted,

Date: February 20, 2008

By: /Jonathan E. Prejean/
Jonathan E. Prejean, Esq.
Reg. No. 52,132

WESTERN DIGITAL TECHNOLOGIES, INC.
20511 Lake Forest Drive
Lake Forest, CA 92630
Tel.: (949) 672-7000
Fax: (949) 672-6604

EXHIBIT A

Sandra Genua

From: Sandra Genua
Sent: Monday, October 25, 2004 2:04 PM
To: 'KROUNBI@SBCGLOBAL.NET'
Subject: Urgent -Patent application papers

Dear Mohamad,

We recently filed a patent application with the United States Patent and Trademark Office on for the invention identified above. At this time, your prompt attention and cooperation are requested. Our deadline for filing the application papers with the Patent Office is November 12, so we will need your papers back as soon as possible.

Please print and review the attached application and drawings describing your invention. To the extent that you are satisfied with the review, please kindly date and sign the enclosed documents: a) **Declaration for Utility or Design Patent Application**, b) **Power of Attorney** or Authorization of Agent, and c) **Assignment of Application**. The last document, Assignment of Application, usually requires an acknowledgment by a Notary Public. **If you do not have access to a notary, please simply sign and date the Assignment.**

Please return all documents to my attention via fax at (949) 672-6604 ASAP. Then, kindly return the originals to me by UPS mail, using the prepaid envelope that I am sending you today.

Thank you for your cooperation with this application. Should you have any questions, please contact me immediately.

Best Regards,
Sandra

Please note that all individuals, including inventors and attorneys, associated with the prosecution of this application have an ongoing duty to disclose to the U.S. Patent and Trademark Office all information of which they are aware which is material to the examination of the application. Such information includes prior publications, products in the marketplace, patents, or other information that may be considered important in deciding whether to allow the application to issue as a patent.

As a means of complying with this duty of disclosure, please let us know if you become aware of any further information, so that we may submit an Information Disclosure Statement beyond that already disclosed.

*Sandra Genua
Lead Patent Paralegal
Western Digital Legal Department
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Sandra.genua@wdc.com*



Figs1-3_R1850.vsd K35R1850 paf.doc R1850-Krounbi-POAR1850-Krounbi-Assi
.pdf gnment.rtf R1850 ADS.doc R1850-Declaration 1-4.pdf R1850-Declaration 5-8.pdf

EXHIBIT B



Western Digital Corporation
Intellectual Property Department
20511 Lake Forest Drive, Suite E118-G
Lake Forest, California 92630
Tel: (949) 672-7000
Fax: (949) 672-6604

February 21, 2006

Mohamad T. Krounbi
14935 Elton Drive
San Jose, CA 95124

VIA UPS DELIVERY

Re: Formal papers for patent application
Entitled: MAGNETIC SENSOR WITH UNDERLAYERS PROMOTING HIGH-COERCIVITY, IN-PLANE BIAS LAYERS
Our Docket Number: R1850

Dear Mohamad,

A patent application was filed with the United States Patent and Trademark Office on February 27, 2004 for the invention identified above. At this time, your prompt attention and cooperation are requested.

Please review the application and drawings to determine whether they accurately describe your invention. To the extent that you are satisfied with the review, please kindly date and sign the enclosed documents: a) **Declaration** for Utility or Design Patent Application, b) **Power of Attorney** or Authorization of Agent, and c) **Assignment** of Application. The last document, Assignment of Application, usually requires an acknowledgment by a Notary Public. **If you do not have access to a notary, please simply sign and date the Assignment.** This patent application contains Western Digital confidential information. Please hold it in confidence and do not disclose it to any other person.

Please fax these documents as soon as possible to my attention at (949) 672-6604.
Thereafter, kindly return the originals to me in the enclosed return addressed UPS envelope for filing with the United States Patent and Trademark Office.

Please note that all individuals, including inventors and attorneys, associated with the prosecution of this application have an ongoing duty to disclose to the U.S. Patent and Trademark Office all information of which they are aware which is material to the examination of the application. Such information includes prior publications, products in the marketplace, patents, or other information that may be considered important in deciding whether to allow the application to issue as a patent.

As a means of complying with this duty of disclosure, please let us know if you become aware of any further information, so that we may submit an Information Disclosure Statement beyond that already disclosed.

If you have any questions, please contact me at your earliest convenience at denise.osullivan@wdc.com or by phone at 949-672-7911.

Sincerely,

Denise O'Sullivan
Administrative Assistant
IP Law Department

EXHIBIT C

Sandra Genua

From: Jonathan Prejean
Sent: Tuesday, April 04, 2006 1:44 PM
To: 'Janyce Mitchell'
Cc: Sandra Genua; jackie@sawyerlawgroup.com
Subject: RE: K35R 1850 (Our docket 3567)

OK, I checked into this one, and it was a case where we weren't able to locate the inventor until relatively recently. We sent the missing parts response without his paperwork, not realizing that he had been left out, and we've only just managed to secure his signature. We're already working on the petition, so please feel free to remove this one from your docket. We'll add the NOA to our file.

Thanks!

*Jonathan Prejean
Patent Attorney
20511 Lake Forest Drive, Lake Forest, CA 92630
949-672-7322 (voice) * 949-672-6604 (fax)*

THIS E-MAIL MESSAGE AND ANY ASSOCIATED ATTACHMENTS ARE CONFIDENTIAL AND ARE INTENDED ONLY FOR THE DESIGNATED RECIPIENTS. THIS MESSAGE AND ITS ATTACHMENTS MAY BE ENTITLED TO PRIVILEGE AS AN ATTORNEY-CLIENT COMMUNICATION, AND/OR AS ATTORNEY WORK PRODUCT. THE SENDER REQUESTS ANY UNINTENDED RECIPIENTS TO REFRAIN FROM USING, DISSEMINATING, FORWARDING, COPYING, OR FURTHER REVIEWING THE MESSAGE. THE SENDER ALSO REQUESTS ANY UNINTENDED RECIPIENTS TO NOTIFY THE SENDER OF RECEIPT AND TO DELETE THE MESSAGE AND ANY ASSOCIATED ATTACHMENTS. THANK YOU.

From: Janyce Mitchell [mailto:janyce@sawyerlawgroup.com]
Sent: Tuesday, April 04, 2006 12:00 PM
To: Jonathan Prejean
Cc: Sandra Genua; jackie@sawyerlawgroup.com
Subject: K35R 1850 (Our docket 3567)

Jonathan and Sandra,

Attached is a Notice of Abandonment received in the above-identified patent application (which had been transferred in from Mark Lauer's office). It appears as though the Office did not receive the Reply to the request to file missing parts. Our file indicates that Sandra filed the response on 11/5/04 (the six month deadline was not until 11/19/04).

Before requesting the Office to withdraw the holding of abandonment, I wanted to be certain that you wanted to have us file the petition.

In addition, for the petition, we would need a stamped postcard if one was sent along with the reply. If a postcard was not sent (which I surmise, because there is not one in the file), please let me know. I will prepare a statement in accordance with 37 CFR 1.8(b), which is filed with the petition. Thanks very much.

Janyce Mitchell
Sawyer Law Group LLP
(650)475-1436

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